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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/913,430 12/09/97 WALKER

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HM22/1106

EXAMINER

SWARTZ, R

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

11/06/01

27

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/913,430

Applicant(s)

Walker et al

Examiner

Rodney P. Swartz, Ph.D.

Art Unit

1645



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27August2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-59, 67, 70-72, and 75-94 is/are pending in the application.
- 4a) Of the above, claim(s) 53-59, 67, and 70-72 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 75-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 53-59, 67, 70-72, and 75-94 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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DETAILED ACTION

1. Applicants' Response to Office Action, received 27 August 2001, paper#26, is acknowledged. Claims 76, 86, 87, 93, and 94 have been amended.
2. Currently, claims 53-59, 67, 70-72, and 75-94 are pending. Claims 53-59, 67, and 70-72 are withdrawn from further consideration by the examiner, 37 CAR 1.142(b), as being drawn to a non-elected invention (Office Action, paper#17, 24 November 1999).
3. Claims 75-94 are under consideration.

Rejections Withdrawn

4. The rejection of claims 86, 87 and 88 under 35 U.S.C. 102(b) as being anticipated by Schaller et al (U.S. Pat. No. 4,894,332) is withdrawn in light of the claim amendments and applicants' argument.
5. The rejection of claims 77-83 and 89-92 under 35 U.S.C. 112, second paragraph, is withdrawn.

Rejections Maintained

6. The rejection of claims 93-94 under 35 U.S.C. 112, second paragraph, as being indefinite for "functional equivalent thereof", is maintained.

Applicants argue that the amendment makes it clear that the term relates only to the amino acid sequences defined by SEQ ID Nos:1 and 2.

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The examiner has considered applicants' argument, but does not find it persuasive.

Claims 93 as amended recites "An amino acid sequence encoded by a DNA fragment comprising SEQ ID NO:1 or a homolog thereof or a functional equivalent of said amino acid sequence."

First, claim 93 is drawn to an amino acid sequence encoded by a DNA fragment "comprising" SEQ ID NO:1. The open language permits any length of additional DNA on either end of SEQ ID NO:1, thus allowing encoding of additional amino acid sequences. The amendment of "functional equivalent of said amino acid sequence" does not restrict this equivalent to only amino sequences encoded by SEQ ID NO:1 but also to sequences encoded by the additional regions which "comprise" SEQ ID NO:1.

Likewise, claim 94 recites "An amino acid sequence comprising SEQ ID NO:2 or a functional equivalent of said amino acid sequence." The open language does not restrict function to merely SEQ ID NO:2, but to any function of any additional amino acid sequences which "comprise" the known region.

7. The rejection of claims 75, 76, 84, 85, and 89-92 under 35 U.S.C. 102(b) as being anticipated by Faulds et al (U.S. Pat. No. 5,252,328) is maintained.

Applicants argue that the claimed antigens are identified by specific antibody probes which manifest a short time after infection and are thus limited by their method of preparation.

The examiner has considered applicants' argument, but does not find it persuasive. First, the limitation of when the sample for antibody is taken is "a short time". This limitation contains no exact definition of what constitutes "a short time". Therefore, the identity of the antigens

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detected by these antibodies are likewise not restricted. Thus, the antigens taught by Faulds meet the criteria of the instant claims.

New Rejections

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

9. Claims 75-94 are rejected under 35 U.S.C. 102() as being anticipated by Bredt et al (U.S. Pat. No. 5,641,638).

The instant claims are directed to *Mycoplasma* antigen and methods of making said antigen by using antibodies isolated from antibody producing cells cultured *in vitro*. The antibody producing cells are isolated from samples taken "a short time" after a mammal has been challenged with *Mycoplasma*.

Bredt et al teach the claimed antigens and methods by using hybridoma cells to produce monoclonal antibodies specific for *Mycoplasma* antigen (abstract; Ex. 1-6).

Conclusion


10. No claims are allowed.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney P. Swartz, Ph.D., whose telephone number is (703) 308-4244. The examiner can normally be reached on Monday through Friday from 6:30 AM to 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F. Smith, can be reached on (703)308-3909. The facsimile telephone number for the Art Unit Group is (703)308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)308-0196.


RODNEY P SWARTZ, PH.D.
PRIMARY EXAMINER
Art Unit 1645

November 5, 2001